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Remarks

Claims 1 through 4 and 7 through 10 remain pending in the application.

The Applicant confirms that an election has been made without traverse to prosecute the invention of Group I. Claims 5 and 6 are withdrawn from further consideration as being drawn to a non-elected invention.

Applicants request permission to amend the specification by replacing the paragraph starting at line 8 on page 2 to correct a typographical error.

The examiner has rejected claims 1 through 4 as obvious over Ayres, Method of Forming a Sand Base Article Using a Decomposable Binder and the Article Formed Thereby, U.S. Patent 5,108,677 (Apr. 28, 1992) in combination with Conrad, Dough Cutter with Interchangeable Cutting Elements, U.S. Patent 4,327,489 (May 4, 1982).

Even if combined, the combination does not meet all of the limitations of the claims. All of the claims require that the blades have a thickness of about .125 inches and a minimum depth of about .03125 inches. Claims 1, 4, 7, and 10 further require that the detail blades be separated from adjacent detail blades by a minimum distance of about .045 inch. These limitations are not present in the combination of Ayres and Conrad. The critical dimensions of the blades are specified such that the device when imprinted in sand or snow will form clean imprints in the desired medium. The critical dimensions are not needed or required in Conrad or Ayres because the inventions in Conrad and Ayres form 3-dimensional objects, not imprinted designs.

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The applicant's invention solves a different problem than cited in the references and such different problem is recited in the claims. In re Wright, 6 USPQ 2d 1959 (1988). The examiner states that Ayres teaches a method of forming an article from a sand and binder mixture which has a dough-like consistency, which is rolled into a sheet which is then subsequently cut or stamped into silhouette shapes using a cookie cutter. Applicant's invention does not form a 3-dimensional object. Applicant's invention does not require a binder to be combined with sand or snow in order for the invention to work. No where does the applicant suggest that an expanse of sand at the beach or in a sand box be rolled into a sheet and then cut to form a 3-dimensional object. No where does the applicant suggest that an expanse of snow be rolled into a sheet and then cut to form a 3-dimensional object. The sand die is used to make an imprint into an expanse of sand or snow and not used to cut into a dough like substance to form a 3-dimensional object.

The prior art references do not contain any suggestion that they be combined in the manner suggested by the Examiner. Ayres discloses that sand and binder be blended to form a dough and then formed into sheets, the sheet is then cut-up using a die to create target preforms. Ayres states that the process is somewhat similar to making cookies with a cookie cutter. Column 4 lines 36 - 43. However, the objects being made in Ayres are shooting targets, which are "highly frangible and fracture upon impact by a projectile." Column 3 lines 66 - 68. The use of the figure impressing walls or indicia of Conrad, Figure 1 item 25, would make the target even more frangible, and would cause the target to fall apart upon production or handling. Shooting targets are typically flung into the air and then shot, and it is unlikely that a frangible object with detailed lines would survive the flinging process. Further, Ayres suggests that the targets be painted to enhance the target visibility. Column 4 line 64. Ayres does not suggest that fine detail lines created by figure

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impressing walls or indicia of Conrad would enhance the target visibility, nor would these fine detail lines even be seen at the distance required in skeet or other target shooting.

Furthermore, the invention as described in Ayres is not that within the scope of the art for one skilled in the art of making pretty designs in a sand box or in snow. One skilled in the art of practicing a method of imprinting sand or snow with a sand die is likely between the ages of 2 and 10 years old. It is unlikely that someone skilled in this art and between the ages of 2 and 10 years old would look to the art of making skeet shooting targets to solve the problem of being bored on the beach, or otherwise be engaged in the activity of skeet shooting.

The problem solved by the invention has never before been recognized, and the recognition of an unrecognized problem militates in favor of patentability. If in fact the Conrad cookie cutter were used to make the frangible objects in Ayres, where the dough in Ayres is part made of sand, the fact that making an impression was not even mentioned or suggested militates in favor of patentability. Furthermore, if the invention were in fact obvious, because of its advantages, those skilled in the art surely would have implemented it by now. That is — the fact that those skilled in the art in Ayres have not implemented the invention, despite its great advantages, indicates that it is not obvious.

Finally, the Office Action has failed to provide a motivation to modify the reference. The examiner states that it would have been obvious to combine the teachings of Ayres and Conrad to provide a method of stamping snow or sand which provides an imprint of a desired shape with a modicum of force by the cookie cutter. The Office Action has merely stated that it would have been obvious to modify the reference in order to accomplish an advantage revealed in the Applicant's own disclosure, and this motivation is not stated in the reference. Thus, the office

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action does not state a prima facie case of obviousness. The Examiner's assumption that it is obvious for one skilled in the art to modify the reference fails to comport with the mandated test for obviousness provided by Graham v. John Deere. Graham v. John Deere replaces outdated maxims and personal opinions with a mandated test for obviousness. Applicant requests that the claims be examined under the standards established by Graham v. John Deere.

Conclusion

This response has addressed all of the Examiner's grounds for rejection. The rejections based on prior art have been traversed. Reconsideration of the rejections and allowance of the claims is requested.

Date: July 1, 2003

By:

  
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